



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/041,416	03/12/98	SCHUSTER	A 4100-98DIV

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EXAMINER

FUNK, S

ART UNIT	PAPER NUMBER
2854	14

DATE MAILED: 02/09/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/041,416

Applicant(s)

Schuster et al.

Examiner

Stephen R. Funk

Group Art Unit

2854



THE PERIOD FOR RESPONSE: [check only a) or b)]

a) ☒ expires 5 months from the mailing date of the final rejection.b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Jan 12, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☒ The proposed amendment(s):

☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☒ will not be entered because:

☐ they raise new issues that would require further consideration and/or search. (See note below).

☒ they raise the issue of new matter. (See note below).

☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: Note the attachment which explains that the proposed amendment to page 8 line 4 would appear to be contradictory.

☒ Applicant's response has overcome the following rejection(s):

All 35 USC 112 rejections of the claims. The objections under 37 CFR 1.75(a) would be overcome upon refiling the proposed amendment to claim 1.

☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: None

Claims objected to: None

Claims rejected: 1-10, 12-22, and 29

☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.

☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s).

☒ Other NOTE THE ATTACHMENT TO PTO-303

Stephen Funk

ATTACHMENT TO PTO-303

Applicant's amendment has not been entered because the proposed amendment to page 8 line 4 would appear to state, in the alternative embodiment, that the non-picture regions being formed where the layer 4 has not been removed is also subjected to the hydrophilizing treatment. Clearly, the remaining toner 2 in the layer 4 is not subjected to this treatment. It would appear to be more accurate to amend lines 3 - 4 to read, for example, "...can be subjected on the non-picture regions for a positive image or on the picture regions for a negative image, i.e. on the regions in which the layer 4 has been removed, to a further treatment...". Accordingly, it is clear that the picture is either a positive or negative of the remaining toner but only the non-toner regions are subjected to the treatment.

With respect to the prior art rejections, the examiner states in the Office Action that Doyle does *not* teach applying liquid toner particles, in addition to not teaching charging the entire form or erasing the fixed toner. However, Raschke et al. do teach charging the entire form as an alternative to charging the toner. Note in the embodiment of Figure 4 of Raschke et al. that the toner is applied *directly* to the charged form. Raschke et al. also teach erasing the fixed toner in column 5 lines 39 - 44. Calabrese et al., and applicant's admission of prior art on page 1 lines 11 - 12, teach the conventionality of using either dry or liquid toner. The alternatives of charging the form, as opposed to the toner, and using liquid toner, as opposed to dry toner, would have been obvious to one of ordinary skill in the art and would appear to be conventional alternatives lacking any teaching of criticality. The motivation to erase the form is self evident.